



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: U.S. Patent Application of	)	
RAINER H. WISCHINSKI	)	Examiner: Lazaro, David R.
	)	
Application No. 09/635,280	)	Conf. No.: 4936
	)	
Filed: August 9, 2000	)	Art Unit: 2155
	)	
For: METHOD AND APPARATUS FOR PROGRAMMING AN AUTOMATION DEVICE	) ) )	Attorney Docket No.: SAA-34-2 (402P230)

**APPELLANT'S PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

Appellant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the reason(s) stated on the attached sheet(s).

Appellant submits this Pre-Appeal Brief Request for Review, in combination with a Notice of Appeal mailed in accordance with 37 C.F.R. §1.8(a) on February 21, 2006. A Request for a One-Month Extension of Time for filing the Notice of Appeal and the required fee is also submitted herewith.

### **ARGUMENTS**

Claims 1-17, 19-21 and 23 are currently pending in this Application. (See Response to Office Action Dated May 3, 2005, pp. 2-5). The Examiner rejected claims 1, 2, 4-9, 11-13, 15, 17, 19-21, and 23 under 35 U.S.C. 103(a) as being unpatentable over Nixon in view of Nookala. (Office Action of October 20, 2005, pp. 2-11)<sup>1</sup>. The Examiner also rejected dependent claims 3, 14 and 16 over Nixon and Nookala and further in view of Ditze, and rejected dependent claim 10 over Nixon and Nookala and further in view of Johnson. (Office Action of October 20, 2005, pp. 11-14). In making these rejections, the Examiner failed to set forth a prima facie showing of obviousness, and instead, improperly used hindsight reconstruction. (See Response to Office Action Dated May 3, 2005, pp. 8-9).

The presently claimed invention is generally directed to a system and method wherein an automation device requests a specific customized application from a plurality of customized applications stored in a network device. The requested customized application is transmitted or downloaded to the automation device. (See Response to Office Action Dated May 3, 2005, pp. 2-5, 6).

Briefly, Nixon discloses a system wherein a user (not the automation device) selects which applications to download to a device. (Response to Office Action Dated May 3, 2005, p. 6). Nookala discloses a system wherein a computer system automatically requests a program from an external data source. (Response to Office Action Dated May 3, 2005, p. 7).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP 2143.01. Second, there must be a reasonable expectation of success. See MPEP 2143.02. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. See MPEP 2143.03. The Examiner has failed to meet each of these criteria.

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<sup>1</sup> The October 20, 2005 Office Action did not have a legible Paper Number. Accordingly, to avoid potentially citing the wrong Paper Number, Applicant will refer to the Title of each paper referenced herein. Cited Art will be referred to by the name provided by the Examiner.

### 1. There Is No Motivation To Combine The References

Applicant respectfully submits the Examiner failed to properly establish a motivation to combine the system of Nixon with features of Nookala. (See Response to Office Action Dated May 3, 2005, pp. 8-9). Instead, the Examiner simply asserts:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Nixon and modify it as indicated by Nookala such that the system further comprises a specific application program request message for the one customized application program received at the network device and sent from the automation device. One would be motivated to have this, as there is need for programming a programmable memory from a remote location (Col. 2 lines 1-3 of Nookala). (Office Action of October 20, 2005, p. 4).

The Examiner's basis for combining the references fails to explain how the cited statement in Nookala would motivate one to modify Nixon to have a device request an application rather than having the user make this selection. Instead, the Examiner simply identifies an alleged "benefit" of the proposed modification to Nixon. However, the mere existence of a perceived benefit does not establish the prior art motivated the modification.

Moreover, the disclosures in Nixon and Nookala would lead one skilled in the art away from the combination purposed by the Examiner. Specifically, Nixon is directed to an interactive system which requires user input for "building a plurality of function blocks and control modules" for downloading to a fieldbus device. (See e.g., Nixon, col. 4, lines 45-67 and col. 32, lines 23-30). In sharp contrast to the interactive system disclosed in Nixon, Nookala is directed to a system which does not require user interaction.

In view of the dissimilar approaches taken by each reference, one skilled in the art would not be motivated to modify Nixon by implementing features from Nookala. In fact, such a modification to Nixon is completely counter to its goal of having "a **user-developed** control strategy." (Nixon, col. 4, lines 41-45).

The Examiner also fails to properly establish a motivation to combine Ditze or Johnson with Nixon and Nookala. (Office Action of October 20, 2005, pp. 12-14). Again, the Examiner

simply identifies an alleged benefit of the combination and does not show where the prior art provides the motivation for combining the references to obtain this benefit.

## **2. There Is No Reasonable Expectation Of Success**

The Examiner also failed to establish any reasonable expectation of success in combining the system of Nixon with features of Nookala. Contrary to the Examiner's position of obviousness, the proposed modification of Nixon would completely alter the system disclosed therein.

As set forth, Nixon discloses a system where a user decides which function blocks or control modules are downloaded into a device. (Response to Office Action of May 3, 2005 p. 6; Nixon, col. 4, lines 45-49). There is no evidence that Nixon would successfully function for its intended purpose if modified so that the device itself requested the function blocks or control modules. In fact, the modification to Nixon proposed by the Examiner would circumvent Nixon's function of providing user-defined control of the system.

It is well settled that where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. *See Tec Air Inc. v. Denso Mfg Michigan Inc.*, 192 F.3d 1353, 1360, 52 USPQ.2d 1294, 1298 (Fed. Cir. 1999); *In Re Gordon*, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Because Nixon would not operate as intended if the user did not define the control strategy, combining Nookala with Nixon would not have been obvious.

## **3. The Prior Art Fails To Disclose Each Claim Limitation**

As acknowledged by the Examiner, Nixon does not disclose each limitation of the claims. Specifically, "Nixon does not explicitly disclose the message being a specific application program request message for the one customized application program." (Detailed Action of October 20, 2005, p. 3).

Similarly, Nookala also fails to disclose a system which requests one customized application from a plurality of customized applications. (Response to Office Action of May 3, 2005, p. 7). Specifically, Nookala fails to disclose how many programs are maintained in the "data source," or whether the "computer system 200" is requesting a specific application from a

plurality of applications as required by each of the independent claims of the present invention.  
(See e.g., Nookala, col. 3, lines 43-46)

#### **4. The Examiner Improperly Used Hindsight Reconstruction**

It appears the Examiner has taken isolated features from the cited references, and has used the claims of the present application as a template. (Response to Office Action of May 3, 2005, p. 9). Such hindsight reconstruction is improper. It is well-recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *In Re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.")

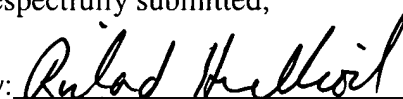
#### **CONCLUSION**

For the foregoing reasons, Appellant respectfully requests withdrawal of the pending rejections, and allowance of claims 1-17, 19-21, and 23.

Respectfully submitted,

Date: February 21, 2006

By:

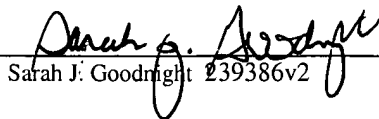


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#### **CERTIFICATE OF MAILING**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Mail Stop AF, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 21, 2006.

  
Sarah J. Goodnight 239386v2